REMARKS

This is intended as a full and complete response to the Final Office Action dated September 8, 2004, having a shortened statutory period for response set to expire on December 8, 2004. Applicants submit this response to place the application in condition for allowance or in better form for appeal. Please reconsider the claims pending in the application for reasons discussed below.

Claims 1, 4-10, 12-15 and 19-37 are pending in the application and remain pending following entry of this response.

Claims 12, and 13 are objected to because claims 12, and 13 are dependent on cancelled claim 11. Applicants have corrected claim 12 to depend from claim 10 and submit that the objection has been obviated.

Claims 1, 4-10, 12-15 and 19-37 stand rejected under 35 U.S.C. 102(e) as being clearly anticipated by *Klein* (USPN 6,496,853). Applicants respectfully traverse the rejection.

The law on anticipation is well settled. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the... claim." *Richardson v. Suzuki motor Co.*, 868 F2d 1226, 1236 (Fed. Cir. 1989). In this case, the rejected claims are not anticipated by *Klein* because *Klein* does not disclose an attribute that identifies an email as one to be checked for redundancy with respect to other emails addressed to the same recipient.

Regarding *Klein*

Klein is directed to the system for managing messages so that messages with redundant contents need not be viewed by a user. Messages with redundant contents can be managed by creating a new message which includes the contents of each of the identified messages but at most a single copy of the redundant contents. (*See*, Abstract.) In *Klein*, management of messages is done by a message manager 157 residing on a recipient computer system 150. (Fig. 1.) Significantly, the message

manager 157 performs a redundancy check for each message received by the recipient computer system 150. (See, Fig. 4 and col. 9, lines 29-50.) That is, the message manager 157 has no way of discriminating between emails whereby selective email management could be achieved. Relatedly, no processing of emails is preformed by the sending computers to selectively identify emails as candidates for redundancy processing by a receiving computer.

Regarding the Claims

In contrast, the present claims configure outbound emails with an attribute that identifies the email as one to be checked for redundancy with respect to other emails addressed to the same recipient. In this way, the sender of emails controls, in part, whether a given email will be checked for redundancy. If the attribute is present for a given email, a redundancy check is necessarily performed by a receiving computer. If the attribute is not present for a given email, a redundancy check is not necessarily performed by a receiving computer. No such functionality is performed by *Klein*. Therefore, *Klein* does not teach, show or suggest configuring an outbound email with an attribute that causes a receiving computer to check the email for redundancy with respect to other emails addressed to the same recipient. Therefore, the claims are believed to be allowable and allowance of the same is respectfully request.

Regarding the Examiner's Response to Applicants' Arguments

In the Final Office Action (paper number 4), the Examiner response to Applicants' argument that Klein does not teach configuring an outbound e-mail with attribute that causes a receiving computer to check the e-mail for redundancy with respect to other e-mails addressed to the same recipient as follows:

Examiner's premise: "In response to Applicant's [*sic*] argument, the Patent Office maintain [*sic*] the rejection because Klein teaches configuring an outbound e-mail with an attribute that cause [*sic*] a receiving computer to check the e-mail for redundancy with respect to other e-mails addressed..." (Examiner Action, paper number 4, page 11.)

Examiner's citation: column 2, lines 40-44; column 3, lines 15-21; and column 10, lines 23-26.

Examiner's conclusion: "[The citation] clearly shows the system for managing messages with redundant contents from the identified messages so that user need not review the redundant messages."

Respectfully, Applicants point out that the Examiner's conclusion does not support the Examiner's premise. Whether *Klein* "clearly shows the system for managing messages with redundant contents from the identified messages" is not the issue. The issue is whether *Klein* teaches a redundancy attribute appended to an electronic-mail message by a sender of the electronic-mail message. *Klein* does not teach such a redundancy attribute. Accordingly, the claims are not anticipated by *Klein*.

Applicants have thoroughly reviewed *Klein* in its entirety, and in particular the portions cited by the Examiner. A redundancy attribute, as claimed, is simply not present in *Klein*. For completeness, the portions of *Klein* relied upon by the Examiner as teaching the claimed redundancy attribute are reproduced below:

> "A system for managing messages so that messages with redundant contents need not be reviewed by a user. Techniques of the invention monitor electronic messages received by a user and determine whether the received electronic messages are related to pending electronic messages for the user, such as by being part of the same message thread. Messages with redundant contents among the related messages are then identified, and the messages with redundant contents are managed so that the user need not review the contents. The messages with redundant contents can be managed by creating a new message which includes the unique contents of each of the identified messages but at most a single copy of the redundant contents. After the new message is created, the identified messages can then be indicated to be redundant in light of the newly created message in one or more ways, such as by deleting the identified messages or by altering the visual indicators of the identified messages presented to the user. Alternately, the messages with redundant contents can be managed by deleting the redundant contents from the identified messages, or by altering the manner in which the redundant contents are presented to allow for easy identification by the user." (Abstract.)

> "...messages with redundant contents can be managed by deleting the redundant contents from the identified messages, or by altering the manner in which the redundant contents are presented to allow for easy identification by the user." (Column 2, lines 40-44.)

"In particular, a Message Manager system monitors electronic messages received by a user, determines whether the received electronic messages are related to pending electronic messages for the user, and identifies messages with redundant contents among the related messages. After identifying messages with redundant contents, the Message Manager system manages the pending messages so that the user need not review the redundant contents." (Column 3, lines 15-24.)

"In order to delete or otherwise indicate the messages with redundant contents, the Message Manager system 157 first identifies for each user the pending messages for that user that have redundant contents. In the illustrated embodiment, message contents are determined to be redundant if those contents are included in the contents of another pending message for the user. In some situations, such as when a recipient has both a copy of a message and a copy of a response to the message, one pending message will include the complete contents of another pending message. In some embodiments, such messages will be managed by deleting the message whose contents are completely included in another message." (Col.6, lines 53-65.)

"If any related messages were identified that have redundant contents, the routine continues to step 435 to create a new empty message. Those skilled in the art will appreciate that the message can be created in a manner similar to that described for a response, message with respect to FIG. 3, thus automatically generating a message subject and message ID that is related to the identified messages. Alternately, the new message could have a message subject or other identifying indicia to show that the message was automatically generated (e.g., appending an `.phi.` to the message name). The routine next continues to step 440 where, for each identified related message, the contents of that message not already present in the new message are added to the new message. The routine then continues to step 445 to delete the identified related messages (including the selected message), and to add the newly created message to the list of new retrieved messages." (Col.9, lines 51-67.)

"Those skilled in the art will appreciate that messages with redundant contents can be managed in a variety of ways. For example, such messages could be indicated as being redundant in light of the newly created message in ways other than being deleted. In addition, messages could be presented to the user when first received, and only processed for redundant contents on a periodic basis or when directed by the user. Moreover, user confirmation could be required before deleting any message identified as having redundant contents, or before deleting a currently pending message that the user may have already reviewed." (Col.10, lines 16-26.)

The above reproductions of *Klein*, on which the Examiner relies, confirm that *Klein* does not teach a redundancy attribute appended to an electronic-mail message by a sender of the electronic-mail message. Rather, the cited portions of *Klein* make clear that *Klein* teaches a "Message Manager system" that checks all received for

redundancy, without regard for whether a redundancy attribute is present in the email for which the redundancy check is being done. In other words, *Klein* performs a redundancy check upon receipt of an email or in response to an explicit user request. The redundancy check of *Klein* is not prompted by, or conditioned on, a redundancy attribute being present with the received email.

Applicants have made every reasonable effort to respond to the Examiner's rejection. If the Examiner still disagrees with the Applicants, the Examiner is kindly requested to point out, with specificity, what teaching of *Klein* is believed to disclose a redundancy attribute appended to an email, by a sender of the email, and which causes a receiving system to perform a redundancy check. Applicants are simply unable to discern any teaching, or even suggestion, of such an attribute in *Klein*.

Therefore, Applicants submit that claims 1, 4-10, 12-15 and 19-37 are patentable over *Klein*.

Having addressed all issues set out in the office action, Applicants respectfully submit that the claims are in condition for allowance and respectfully request that the claims be allowed.

Respectfully submitted,

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